

REMARKS

The Office Action mailed August 6, 2007 has been carefully considered. Within the Office Action Claims 1-10 have been rejected. The Applicants have amended Claims 1 and 8-10. In addition, the Applicants have added new Claims 11-15. Reconsideration in view of the following remarks is respectfully requested. A three (3) month extension accompanies this Reply.

Rejection under 35 U.S.C. § 103

Claims 1-4 and 10 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable to Roitman et al. (U.S. 2003/0017305) in view of Sasaki et al. (“Screen Printed Adhesive Technologies for All-Silicon Optical Packaging” – listed in IDS) and/or Ringleben et al. (U.S. 2005/0173059) and/or Khan et al. (US 2004/0020595). This rejection is respectfully traversed.

Claims 5-6 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable to Roitman et. al. in view of Sasaki et al. and/or Ringleben et al. and/or Khan et al. as applied to claim 4, and further in view of Eisenbeiss et al. (US 2005/0077175). Claim 7 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable to Roitman et. al. in view of Sasaki et al. and/or Ringleben et al. and/or Khan et al. as applied to claim 4, and further in view of Soane et al. (US 6176962). Claims 8-9 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable to Roitman et. al. in view of Sasaki et al. and/or Ringleben et al. and/or Khan et al. as applied to claim 4, and further in view of Lum et al. (US 5932315).

In determining obviousness four factual inquiries must be looked into in regards to determining obviousness. These are determining the scope and content of the prior art;

ascertaining the differences between the prior art and the claims in issue; resolving the level of ordinary skill in the pertinent art; and evaluating evidence of secondary consideration. Graham v. John Deere, 383 U.S. 1 (1966); KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007) (“Often, it will be necessary . . . to look into related teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit.**”)
(emphasis added).

The Applicants’ specification describes a process of applying glue to a substrate in which the recesses are prevented from receiving the glue based on the novel method described. In particular, Applicants’ process involves the use of a mask-less grid which comes into contact with the substrate and allows the glue to be applied to the surface of the substrate without getting the glue into the recesses. Applicants’ specification describes that typical screen printing processes involve the use of a mask or stencil, whereby the process applies to larger patterns, such as larger than 300 μm . (Applicants’ specification, Page 8, Lines 21-22). However, the use of a mask-less grid provides control of the substrate surface energy to achieve a glue coating that better conforms with the micro-patterns in the substrate without closing off the recesses in the substrate with glue. (Applicants’ specification, Page 8, Lines 23-27).

In contrast, Roitman merely describes in general terms that screen printing can be used to apply adhesive to the substrate. However, Roitman does not disclose that a mask-less grid is utilized in applying adhesive to the substrate. In fact, one skilled in the art reading Roitman would realize that Roitman does not seek to resolve the problem of preventing glue from entering the recesses in the substrate considering that Roitman mentions that other possible ways of

applying the adhesive include “spraying,” “dip-coating,” and “brushing.” These methods mentioned in Roitman certainly do not prevent glue from entering the recesses. Therefore, Roitman does not teach or suggest a mask-less grid, as claimed in Claim 1.

One skilled in the art combining Roitman with Sasaki would not reach each and every element/limitation in Claim 1 to satisfy a proper obviousness rejection. Sasaki not only expressly discloses using a screen mask, but also describes the requirement of using the screen mask as it “is the most important for thickness control.” (Sasaki, Page 1291, First Paragraph). Accordingly, Claim 1 is patentable over the combination of Roitman and Sasaki.

In addition, one skilled in the art combining Roitman with Khan would not reach each and every element/limitation in Claim 1 to satisfy a proper obviousness rejection. Khan effectively admits using a screen 30 having apertures 32 in a grid pattern which is in contact with the upper frame portion 12. (Khan, Paragraph 0020). In other words, the screen 30 with grid pattern is a mask, which is not what is recited in Claim 1. Accordingly, Claim 1 is patentable over the combination of Roitman and Khan.

Regarding Ringleben, Ringleben cannot be used in a 35 U.S.C. 103 analysis as it is not considered prior art under 35 U.S.C. 102. Ringleben has a filing date of February 11, 2004, whereas the present application claims priority to French foreign application 03/50218 filed June 16, 2003. Accordingly, the filing date of the present application predates that of Ringleben and thus, Ringleben cannot be used as prior art.

Claims 2-10 are dependent on Claim 1. For at least the reasons stated above, Claim 1 is allowable over the combination of Roitman, Sasaki and Khan. Accordingly, Claims 2-10 are also allowable for being dependent on an allowable base claim.

New Claims

The Applicants have added new Claims 11-15 to the present application. The Applicant believe that the new claims are fully supported by the specification and no new matter has been added. Allowance of new Claims 11-15 is respectfully requested.

Conclusion

It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698. A three (3) month extension accompanies this Reply.

Respectfully submitted

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